

Appl. No. 10/672,645
Amdt. dated May 11, 2005
Reply to Office action of Mar 22, 2005

Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 4. This sheet, which includes Fig. 4-6, replaces the original sheet including Fig. 4-6. In Figure 4, items 142 and 150 have been added to show a second rotating member.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

Appl. No. 10/672,645
Amdt. dated May 11, 2005
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REMARKS/ARGUMENTS

Figure 4 was modified to include a secondary rotating member 150 connected to the first rotating member with a bearing 142.

Claim 1 was modified as shown below.

Claim 1 (Amended): A wheel cover for a vehicle comprising;

an a first inner member with attachment mechanism for connecting the first member to a vehicle rim,

a second at least one outer member that is not eccentrically weighted,

a bearing mechanism that connects the first inner member to the second outer member to allow the members to turn independently from each other, and wherein the second member is located outside the first member away from the vehicle rim.

These changes identify that the second member is located outside the first member, away from the vehicle rim. These changes are supported in the specifications and the figures.

Claim 8 was modified as shown below.

Claim 8 (Amended) A wheel cover for a vehicle comprising;

an a first inner member with attachment mechanism for connecting the first member to a vehicle rim,

a bearing mechanism connected to at least a part of the first inner member and the a bearing mechanism is connected to at least a part of a second an outer member where;

the second member is located outside the first member away from the vehicle rim,

the second outer member can spin or turn independent from the first inner member, and,

Appl. No. 10/672,645
Amdt. dated May 11, 2005
Reply to Office action of Mar 22, 2005

at least a portion of the rotational inertia from the first inner member turning is transferred to the second outer member.

These changes require that the intensity of the light source is at least partially controlled by the intensity of the light external to the picture frame.

These changes identify that the second member is located outside the first member, away from the vehicle rim. These changes are supported in the specifications and the figures.

Claims 3 and 10 were modified as shown below.

Claim 3 (Amended) The attachment mechanism in claim 1 where the attachment mechanism consists of one or more magnets to retain the first member to the vehicle rim.

Claim 10 (Amended) The attachment mechanism in claim 8 where the attachment mechanism consists of one or more magnets to retain the first member to the vehicle rim.

These changes identify the purpose of the magnets is to retain the first member to the vehicle rim.

Claims 4-7 and 11-14 were modified to accommodate word changes in claims 1 and 8. The word changes accommodate the change of the word "inner member" to "first member" and "outer member" to "second member".

Claims 4, 5, 11, and 12 have been modified to incorporate correct Markush group recitation language.

Appl. No. 10/672,645
Amdt. dated May 11, 2005
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Claims 2-7 and 9-14 were corrected to overcome the claim objections.
The claims have been corrected to recite proper dependant claim structure.

Novelty (35 USC § 102)

The Office considers claims 1, 7-8 and 14 rejected under 35 U.S.C. 102(b) for being anticipated by Whiteman (US 2,997,344). The applicant disagrees based upon the changes made to claims 1, 8.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (MPEP § 2131)

Based upon the above analysis, Whiteman lacks disclosure of each and every limitation of the claims as required by MPEP § 2131, namely that Whiteman discloses the outer hub cap (13) col 1, lines 66-69 attaches to the vehicle rim (13') and that the inner spinning hub (31) col 2, lines 20-22 is located between the outer hub cap and the vehicle rim as shown in the cross sectional view, figure 2. In the pending application, the second or spinning member is located on the outside of the member that is attached to the vehicle rim. This is the opposite configuration patented and disclosed by Whiteman.

The Office considers claims 1,2, 7-9 and 14 anticipated under 35 U.S.C. 102(b) for being anticipated by (Wang US 6,702,396).

A rejection under 102(b) requires that:

Appl. No. 10/672,645
Amdt. dated May 11, 2005
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"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States, or"

Wang was filed January 24, 2003 the patent was issued/published on March 9, 2004. The pending application was filed September 26, 2003, based upon the first available patented / published date of Wang and the filing date of the pending application, Wang is not available as a reference under 35 USC §102(b).

Obviousness (35 USC § 103)

The Office considers claims 2, 4-6, 9, 11-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Whiteman (US 2,997,344) in view of Wallach (US 6,820,475). The applicant disagrees in regards to claims 4-6, 9, 11-13 based upon the changes made to claims 1 and 8 by virtue of their dependence on independent claims 1 and 8.

The office considers claims 4-5, 11-12 rejected under 35 U.S.C. 103(a) as being unpatentable as obvious material choices based upon commonality of available materials and design considerations. The applicant disagrees in regards to claims 4-5, 11-12 based upon the changes made to claims 1, and 8 by virtue of their dependency on independent claims 1 and 8.

The office considers claims 6 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over a modification of the Whiteman patent. The Whitman patent discloses that the spinning member is located between the outer cover and the

Appl. No. 10/672,645
Amdt. dated May 11, 2005
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vehicle rim. Since the spinning member is only visible when the inner member covers the outer member there is no obvious motivation to combine the components.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

There is no suggestion or motivation in the Whitman, nor is there teaching or suggestion in Whitman, to provide a second or additional spinning members. The applicant further disagrees based upon the comments made and changes made to claims 1, and 8 by virtue of their dependency on independent claims 1 and 8.

The considers claims 3 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Whiteman (US 2,997,344) in view of Schurig (US 6,135,569). The applicant disagrees in regards to claims 3 and 10. Schurig does not use magnets to attach the hub cap to the vehicle rim, Schurig uses the magnets to create a magnetic field so the spinning member returns to an pre-determined orientation (abstract and col. 3, lines 51-59). There is further no motivation or teaching in either Whiteman or Schurig to use magnets to attach the inner or first member to the vehicle rim. Claims 3 and 10 are also not obvious based upon the changes made to claims 1 and 8 by virtue of their dependence on independent claims 1 and 8.

Appl. No. 10/672,645
Amdt. dated May 11, 2005
Reply to Office action of Mar 22, 2005

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
BUHLER & ASSOCIATES

By /Kirk A. Buhler/

Kirk A. Buhler
Reg. No. 52,670
Tel.: (951) 515-6447

Figure Attachments

Appl. No. 10/672,645

Amdt. dated May 11, 2005

Reply to Office action of Mar 22, 2005

Appl. No. 10/672,645

Amdt. Dated May 11, 2005

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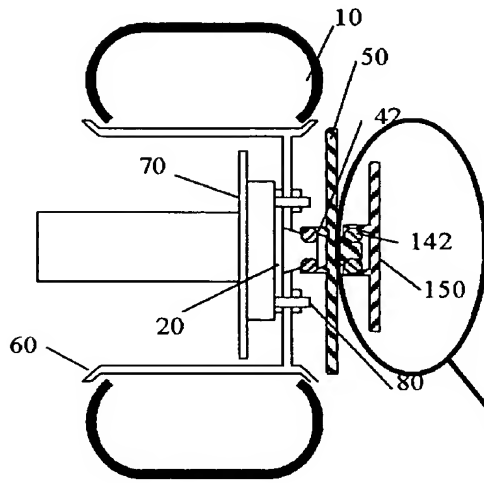


FIG 4

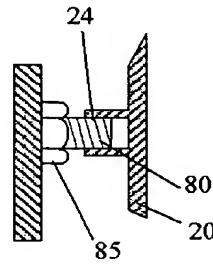


FIG 5

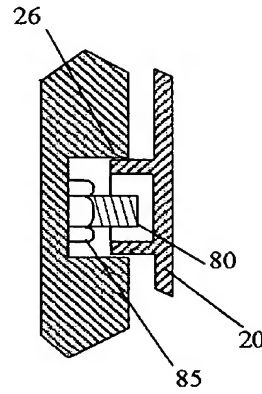


FIG 6

Items 142 and 150
added to show
additional spinning
member

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